Examiner are contained in the Amendments section within this Response. Such corrections and the amendments avoid the rejections raised by the Examiner and do not add any new matter to the invention being claimed, thus making such Claims conform to the arguments of the Examiner and place the Claims in proper form for issuance.

Regarding the rejection of Claim 1 based upon 35 § 102, the Applicant does not contest this rejection based upon McGee '875. In light of this, Applicant requests that Claim 1 be cancelled, leaving Claims 2-5 to be reviewed and examined in light of the amendments to these claims and the argument and authority cited below.

Addressing the rejection based upon 35 USC § 103, the Examiner has based his rejection on the combined teachings of McGee and Schenavar '829. Applicant respectfully disagrees with this rejection, in whole or in part under the following comparisons to establish a plausible distinction. The following standard is applicable.

> "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of its success must both be found in the prior art, and not based on the applicant's disclosure." MPEP § 2142.

First, a distinction can be drawn between the "individual tread plates linked together by a linking plate and linking pins" and the plurality of geared arms of McGee. The rigid tread plates of the current invention, while somewhat deformable when linked together in series, are not pivotally attached as are the geared arms of McGee. In McGee, these arms have teeth that engage gear teeth on the spindle end of the spindle end of the spindle arm. Column 5, lines 3-23. These geared arms are pinched between the geared arms, and as the geared arms are depressed, they force the spindle

downward. The current invention has no teeth or engagement with the driver arm. The driver arm is attached to the underside of the top end piece, which is not the deformable upper plate or the tread plate, the top end piece being part of the upper piston cap. This distinction is outside the scope of the combined teaching of McGee and Schenavar.

Second, a distinction can be drawn in the spindle of McGee and the racks and pinions of Schenevar. In McGee, the spindle is driven downward, while the spiral crew-thread ensemble on the spindle engage a yoke carried on the spindle-surrounding interior of the rotor. By interpreted function, this spindle causes the generating means to rotate perpendicular to the downward and upward reciprocation of the spindle, creating, as stated, a reciprocation-to-rotation conversion subassembly. Column 3, line 59 to column 4, line 11. In the present invention, a more simple edification of the generating means is a singular simple descending driver arm and its contact with a drive gear on a generator rotating the drive gear one way when depressed and the other way when extension occurs, creating an alternating spin of the drive gear.

As to the Schenavar patent, there are two racks, one defined as an up drive rack and another defined as a down drive rack, each of the two racks driving a respective up drive pinion and a down drive pinion, the teeth of the up drive rack engaging the teeth of the up drive pinion through longitudinal slots in the up drive rack housing, with the teeth of the down drive rack engaging the teeth of the down drive pinion through longitudinal slots in the down drive rack housing. Column 1, line 55 to column 2, line 22. A clutch is also involved which disengages each rack from its pinion allowing for a free spin of the generating device to impart only one direction of spin to the generating device. Column 2, lines 23-41. This is distinguishable from the lngle descending driver arm engaging the single drive gear of the generator arm, again, having much fewer parts involved in the generation of the electrical current.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In Re Geiger, 815 F.2d 686, 2 U.S.P.Q. 2d 1276 (C.A.F.C. 1987); In Re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (C.A.F.C. 1988).* Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art. *In Re Vaeck, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (C.A.F.C. 1991).* The rack, pinion, clutch, and two distinct drive arms of Schenavar are a different combination of components than the current invention. The geared arms, the gear teeth of the spindle, the second set of threads on the spindle engaging the spiral screw thread assembly engaging the yoke with the spindle surrounding interior of the rotor are also a different combination of components than the current invention. The art upon which the rejections are based do not fulfill this requirement and are clearly distinguishable.

There is nothing wrong in defining something by what it does rather than by what it is. *ReEcherd, 471 F2d. 632, 176 USPQ 321 (1973, CCPA); Re Swinehart, 439 F2d. 210, 169 USPQ 226 (1971, CCPA); Re Fuetterer, 319 F2d. 259, 138 USPQ 217 91963, CCPA).* The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin 170 USPQ 209 (CCPA 1971).* Finally, a reference which leads one of ordinary skill in the art away from the claimed invention can not render it unpatentably obvious. *Dow Chemical Co. v. American Cyanamid Co., 816 F.2d 617, 2 U.S.P.Q. 2d 1350 (C.A.F.C. 1987); In Re Dow Chemical Co., 837 F.2d 469 5 U.S.P.Q. 2d 1529 (C.A.F.C. 1988).*

In this instance, the multiple elements involved in McGee leads one away from the simplicity

of the current invention, having far less components to fail to meet the objective. There are no pivoting geared arms, there are no spindle teeth on the top of a spindle, there are no threads on the spindle engaging a yoke in a reciprocation-to-rotation conversion, and there is not a conversion assembly, a generator assembly, a first subassembly or the intercept subassembly, a second subassembly, or the axially-reciprocating subassembly, nor a third subassembly or the reciprocation to rotation conversion subassembly.

Likewise, the up drive rack, pinion, clutch and up-drive rack housing and the down drive rack, pinion, clutch and down-drive rack housing, each operating at different times in the stated continual generation of electrical power, leads one away from the simplicity of the current invention, the current device having a single drive arm, a single drive gear, the entire generating device contained in the interior cavities of an upper piston cap and a base piston shell without the complexity of integrated parts of the two cited prior art patents distinguishes the current invention from the prior art, singularly or in combination.

Granted, each of the three devices generates power, although Schevanar does so being mounted to an axle and wheel of a motor vehicle as opposed to being imbedded in a roadway. however, the integrated components are distinguishably different and one cannot read into a patent what is not there, nor eliminate items that are contained in the patent which, by absence in the current invention, provide distinction.

"Prior structures which by modification might be made to perform functions of a later patented device are not anticipations where not designed, adapted to nor used for such functions, and prior art patents cannot be modified or reconstructed in the light of the subsequent invention to build up an anticipation." *Payne Furnace and Supply Co. v Sheridan, 71 F2d 935 (1934, CA 1 Mass).* The prior description must disclose clearly, truly and full what the subsequent patentee invented and

accomplished. *Seabury v Am Ende, 152 US 561, 14 S Ct 683 (1894).* Published descriptions leading up to but not fully accomplishing the desired end of the invention have been held not to anticipate. *Re Cole, 18 CCPA 880, 46 F2d 575, 8 USPQ 260 (1931).*

Applicant respectfully request a withdrawal of the rejection based upon § 103 and for the Examiner to allow Claims 2-5 to pass onto issue, along with the amendments made below.

AMENDMENTS

In the Specification

Please amend the abstract of the invention as follows:

In line 1, change "invention" to – roadway electric generator –. A substitute abstract is as follows.

Marked up version of Abstract.

ABSTRACT OF INVENTION

The ~~invention~~ roadway electrical generator is an electrical generating device and method utilizing the potential energy of moving traffic on highways to generate three phase electrical current, the device comprising a large plurality of compressible electrical generator pumps underneath upper and lower plates located between the road bed and the travel surface of the highway activated by the compression weight of a moving vehicle over the travel surface of the roadway.